

REMARKS

The Office Action mailed December 20, 2001 required an election under 35 U.S.C. 121 from among:

Species A, claims 1 to 6, drawn to a method of manufacturing a semiconductor device comprising a step of selectively grinding or polishing the peripheral portion and the beveled portion of the side of the main surface of target substrate including the semiconductor substrate,

Species B, claims 7 to 12, drawn to a method of manufacturing a semiconductor device comprising a step of grinding or polishing the peripheral portion and the beveled portion on the side of the main surface of the semiconductor substrate covered with the polysilicon film,

Species C, claims 13 to 20, drawn to a method of manufacturing a semiconductor device comprising a step of grinding or polishing the peripheral portion and the beveled portion on the side of the main surface of the semiconductor substrate covered with the metal layer, and

Species D, claims 21 and 22, drawn to a method of a method of manufacturing a semiconductor device comprising a step of grinding or polishing the peripheral portion and the beveled portion on the side of the main surface of the semiconductor substrate covered with the film containing the contaminant material.

Applicants provisionally elect, with traverse, for further prosecution in this application the invention identified in the Office Action as Species A, claims 1 to 6.

Species A, B, C and D are related to each other in that all four species are directed to a method of manufacturing a semiconductor device involving a step of grinding or polishing the peripheral portion and the beveled portion on the surface of the semiconductor substrate. If the restriction requirement is nonetheless maintained, Applicants reserve the right of rejoinder of the subject matter of the non-elected claims.

It is respectfully submitted that examination of all of the claims pending in this application is in the spirit of the right of rejoinder such that the restriction requirement should be reconsidered, and reformulated or withdrawn entirely.

It would seem, that to require the filing of three separate divisional applications directed to Species B, C and D claims will result in the very same search being repeated, but at a later date. It is submitted that these duplicate searches would be quite inefficient to the operation of the Patent and Trademark Office. Furthermore, it is likely that the same Examiner would be in charge of the divisional cases; but since those divisional applications will be examined at a much later date, the Examiner will have to conduct duplicate, redundant searches at the time he examines the divisional applications. Alternatively, if a different Examiner were assigned to the divisional applications, a significant loss of PTO efficiency would be incurred as a result of the examination of the divisional cases.

Thus, the only logical outcome of the present restriction requirement would be to delay the examination of the Species B, C and D claims, resulting in inefficiencies and unnecessary expenditures by Applicants and the PTO, and since a single search can be performed for all four species of claims without any significant burden on the Office, it is respectfully requested that this restriction requirement be withdrawn.

In this regard the Examiner is respectfully invited to consider the extreme prejudice to Applicants by the present restriction requirement, including: the necessity of having to pay three additional filing fees to the PTO and others for prosecuting three additional applications; and, the loss of patent term for Species B, C and D claims if Applicants must now file separate applications at this time directed thereto due to prosecution of such applications beginning far later than prosecution to date in the present application, and to the post-GATT 20

year from earliest U.S. filing date patent term and also in view of the enactment of the American Inventors Protective Act.

Additionally, the Examiner is respectfully invited to review the text of MPEP §803, which in part states (with emphasis) that:

If the search and examination of an entire application can be **made without serious burden, the examiner must examine it on the merits**, even though it includes claims to distinct or independent inventions.

The results of the present restriction requirement are inefficiencies and unnecessary expenditures by both the Applicants and the PTO, and extreme prejudice to Applicants; and, restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action, there are relationships among Species A, B, C and D claims all of which militate against restriction.

Hence, it is evident that there is unity of invention and allowable subject matter in the pending claims, and in view of the foregoing, reconsideration and withdrawal of the requirement for restriction and favorable consideration of all of the claims on the merits are respectfully requested.

Thus, if the restriction requirement is nonetheless maintained, Applicants reserve the right of rejoinder, as mandated by the MPEP.

Any additional fee occasioned by this paper, or any overpayment in those fees, may be charged or credited to Deposit Account No. 50-0320.


Early and favorable examination of all of the claims on the merits is respectfully requested.

In view of the foregoing, reconsideration and withdrawal of the requirement for restriction and favorable reconsideration of Species A, B, C and D on the merits are respectfully requested.

Respectfully submitted,

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